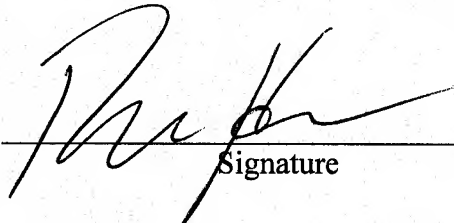


| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number | |
|---|--|----------------------|-------------------|
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | | Application Number | Filed |
| | | 10/787,130 | February 27, 2004 |
| | | First Named Inventor | |
| | | Naoyuki EZUKA | |
| | | Art Unit | Examiner |
| | | 3643 | John D. HOLMAN |
| WASHINGTON DC SUGHRUE/265550 65565 CUSTOMER NUMBER | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>32,778</u></p> <div style="text-align: right;"> _____ Signature</div> <div style="text-align: right;"><u>Brian W. Hannon</u> Typed or printed name</div> <div style="text-align: right;"><u>(202) 293-7060</u> Telephone number</div> <div style="text-align: right;"><u>August 13, 2007</u> Date</div> | | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q80148

Naoyuki EZUKA

Appln. No.: 10/787,130

Group Art Unit: 3643

Confirmation No.: 4669

Examiner: John D. HOLMAN

Filed: February 27, 2004

For: FISHING ROD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 11, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claims 1-4, 7-13, 15 and 16 are all the claims pending in the application. Claims 1, 7 and 9 are independent. The prior art rejections can be found in the Final Office Action and are not repeated herein for the sake of brevity.

Claim 1 recites¹:

A fishing rod comprising:

¹ Reference numerals have been added for the convenience of the review panel.

*a rod pipe (12);
a tubular body (17) to which the rod pipe is inserted and fitted;
a tubular transparent synthetic resin body (16) integrally molded
with the tubular body (17);
a concealing film (19) formed on at least one edge face portion of
the synthetic resin body; and
a grip portion (18) to which the tubular transparent synthetic resin
body is fixed with the concealing film disposed therebetween; and
an adhesive agent for fixing the grip portion and the concealing
film formed on the transparent synthetic resin body.*

Applicants submit that Yamamoto '223 does not teach or suggest a tubular transparent synthetic resin body which is integrally molded with the tubular body. The Examiner asserts that reference numeral 12 of Yamamoto '223 corresponds to the tubular body and that reference numeral 13 and 14 correspond to the claimed tubular transparent synthetic resin body. However, members 13 and 14 of Yamamoto, et al. '223 are glued to member 12; they are not integrally molded together. This is an important distinction. As noted in the last response, Yamamoto, et al. '223 specifically states that elements 12 and 13 are fixedly bonded to each other. See, column 4, lines 20-23. The specification of the present application at page 13, lines 17-22 describes the advantage of the claimed invention (in which the resin body 16 is integrally molded with the tubular body 17) over the arrangement disclosed in Yamamoto, et al. '223. Specifically, the specification states as follows:

Moreover, the synthetic resin body 16 is formed integrally with the outer side of the reinforced tubular body 17 by molding

and the reinforced tubular body 17 is fixed to the rod pipe 12, whereby the synthetic resin seat body can be secured firmly to the rod pipe 12. Particularly since the resin seat body is not bonded to the reinforced body 17 but formed integrally with the reinforced tubular body 17 by molding, the reinforced tubular body 17 externally looks beautiful as seen from the outside of the transparent synthetic resin seat body 16.

Thus, the specification specifically distinguishes the claimed arrangement over that disclosed in Yamamoto, et al. '223 and highlights the advantage associated with the claimed invention. In the Advisory Action and for the first time, the Examiner asserts that when an advantage of a claimed feature relates to aesthetic appearance, the claimed feature is not given patentable weight. *See* Advisory Action at 2.

There are two problems with this. First, the Examiner provides no support for this assertion, failing to cite to any case law or to the MPEP. Second, the position taken by the Examiner in the Advisory Action is contradictory to the position taken during the earlier prosecution of this application in which he states that "the Examiner maintains that both Yamamoto references disclose the integrally molded relationship that is disclosed and claimed in the present invention." Final Office Action at 6. It should be pointed out that the Yamamoto patents are assigned to the same assignee as the subject application. The invention described and claimed in the subject application is intended to overcome the problems with the Yamamoto designs.

Clearly the Examiner has failed to establish a prima facie case of obviousness with respect to this feature contending on the one hand that the prior art discloses this feature, and

after realizing that the prior art does not disclose it, contending that the feature is a matter of design choice.

In addition, Applicant submits that Yamamoto '223 fails to even teach or suggest a grip portion. Instead, the Examiner is reading element 13 on both the synthetic resin body and the grip portion of claim 1.

Finally, Applicant submits that Yamamoto, et al. '223 does not teach or suggest a concealing film disposed between the resin body and the grip portion, as required by claim 1. More specifically, claim 1 recites:

*a concealing film (19) formed on at least one edge face portion of
the synthetic resin body; ...
an adhesive agent for fixing the grip portion and the concealing
film formed on the transparent synthetic resin body.*

In rejecting claim 1, the Examiner seems to contend that a bonding agent corresponds both to the claimed concealing film and to the adhesive agent for fixing the grip portion and the concealing film. Clearly, this is improper. The reference fails to disclose the concealing film the purpose of which is to conceal the bonding agent.

Based on the foregoing, it is submitted that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1.

Turning to the rejection of claim 7, as discussed above with respect to Yamamoto, '223, Yamamoto, '302 likewise does not teach a synthetic resin body which is integrally molded with an outer side of the tubular body, as claim 7 also requires. Further, there is no support for the Examiner's assertion that the synthetic resin body includes a portion larger in thickness than the

tubular body and made of a material softer than that of the tubular body. Finally, there is no support for the Examiner's assertion that Yamamoto, et al. '302 teaches that the reinforced tubular body extends in an axial direction longer than that of the synthetic resin body. The Examiner's assertion that there is no reference point from which to measure (*see* Final Office Action at 6) makes no sense; it is the relative lengths of the two elements that are being compared - from one end to the other end!

Finally, independent claim 9 includes the same distinguishing features discussed above in regard to claims 1 and 7 (integrally molded; concealing film; the synthetic resin body includes a portion larger in thickness than the tubular body and made of a material softer than that of the tubular body). Thus, it is submitted that claim 9 is likewise allowable over the art.

Based on the foregoing, it is believed that the application is in condition for allowance.

Respectfully submitted,



Brian W. Harmon
Registration No. 32,778

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

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